

REMARKS

Claims 1-9 were previously pending in the present application.

No claims are currently canceled or added.

Claims 1-7 are currently amended.

Claims 1-9 remain pending in the present application.

Claims 1-9 have been rejected.

Reconsideration of the present application in light of the above amendments and the following remarks is respectfully requested.

Rejections under 35 U.S.C. §102: Gano**Claim 1 in view of Gano**

Claim 1 recites:

1. An apparatus, comprising:
 - a subterranean formation defining a wellbore;
 - a tubular wellbore casing positioned within and coupled to the wellbore;
 - a first tubular liner positioned within the wellbore overlapping with and coupled to the wellbore casing;
 - a second tubular liner positioned within the wellbore and overlapping with and coupled to the first tubular liner;
 - wherein the second tubular liner is coupled to the first tubular liner by:
 - machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing; and
 - inserting an end of the second tubular liner into the machined end of the first tubular liner.

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,065,543 to Gano, et al. ("Gano").

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain this rejection with respect to claim 1, Gano must contain all of the above claimed elements of the claim. However, at least in the context of claim 1, Gano does not teach that the second tubular liner is coupled to the first tubular liner by machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing and then inserting an end of the second tubular liner into the machined end of the first tubular liner. Accordingly, the §102 rejection of claim 1 is not supported by Gano. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 3 in view of Gano

Claim 3 recites:

3. A method for extracting fluidic materials from a subterranean formation including a wellbore that traverses the formation and a wellbore casing positioned within and coupled to the wellbore, comprising:
coupling an end of a tubular liner to an end of the wellbore casing;
machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end;
inserting an end of another tubular liner into the machined end of the tubular liner; and
sealing the interface between the other tubular liner and the wellbore casing.

Claim 3 was also rejected under 35 U.S.C. §102(b) as being anticipated by Gano. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 3, Gano must contain all of the above claimed elements of the claim. However, Gano does not teach machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 3. Accordingly, the §102 rejection of claim 3 is not supported by Gano. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 5 in view of Gano

Claim 5 recites:

5. A system for extracting fluidic materials from a subterranean formation including a wellbore that traverses the formation and a wellbore casing positioned within and coupled to the wellbore, comprising:

means for coupling an end of a tubular liner to an end of the wellbore casing;

means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end;

means for inserting an end of another tubular liner into the machined end of the tubular liner; and

means for sealing the interface between the other tubular liner and the wellbore casing.

Claim 5 was also rejected under 35 U.S.C. §102(b) as being anticipated by Gano.

However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 5, Gano must contain all of the above claimed elements of the claim. However, Gano does not disclose means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 5. Accordingly, the §102 rejection of claim 5 is not supported by Gano. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 7 in view of Gano

Claim 7 recites:

7. In an apparatus comprising a subterranean formation defining a wellbore that includes a wellbore casing positioned within and coupled to the wellbore and a tubular liner coupled to an end of the wellbore casing, a method of conveying fluidic materials to and from the tubular liner, comprising:

machining the end of the tubular liner while the tubular liner is coupled to the wellbore casing end within the wellbore;

inserting and supporting an end of another tubular liner in the machined end of the tubular liner; and

conveying fluidic materials to and from the tubular liner using the other tubular liner.

Claim 7 was also rejected under 35 U.S.C. §102(b) as being anticipated by Gano. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 7, Gano must contain all of the above claimed elements of the claim. However, Gano does not disclose machining the end of the tubular liner while the tubular liner is coupled to the wellbore casing end within the wellbore, at least in the context of claim 7. Accordingly, the §102 rejection of claim 7 is not supported by Gano. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Rejections under 35 U.S.C. §102: Themig

Claim 1 in view of Themig

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,942,925 to Themig (“Themig”). However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 1, Themig must contain all of the above claimed elements of the claim. However, at least in the context of claim 1, Themig does not teach that the second tubular liner is coupled to the first tubular liner by machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing and then inserting an end of the second tubular liner into the machined end of the first tubular liner. Accordingly, the §102 rejection of claim 1 is not supported by Themig. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 3 in view of Themig

Claim 3 was also rejected under 35 U.S.C. §102(b) as being anticipated by Themig. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 3, Themig must contain all of the

above claimed elements of the claim. However, Themig does not teach machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 3. Accordingly, the §102 rejection of claim 3 is not supported by Themig. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 5 in view of Themig

Claim 5 was also rejected under 35 U.S.C. §102(b) as being anticipated by Themig. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 5, Themig must contain all of the above claimed elements of the claim. However, Themig does not disclose means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 5. Accordingly, the §102 rejection of claim 5 is not supported by Themig. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 7 in view of Themig

Claim 7 was also rejected under 35 U.S.C. §102(b) as being anticipated by Themig. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 7, Themig must contain all of the above claimed elements of the claim. However, Themig does not disclose machining the end of the tubular liner while the tubular liner is coupled to the wellbore casing end within the wellbore, at least in the context of claim 7. Accordingly, the §102 rejection of claim 7 is not supported by Themig. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Rejections under 35 U.S.C. §102: Bussear

Claim 1 in view of Bussear

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,743,335 to Bussear (“Bussear”). However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect

to claim 1, Bussear must contain all of the above claimed elements of the claim. However, at least in the context of claim 1, Bussear does not teach that the second tubular liner is coupled to the first tubular liner by machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing and then inserting an end of the second tubular liner into the machined end of the first tubular liner. Accordingly, the §102 rejection of claim 1 is not supported by Bussear. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 3 in view of Bussear

Claim 3 was also rejected under 35 U.S.C. §102(b) as being anticipated by Bussear. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 3, Bussear must contain all of the above claimed elements of the claim. However, Bussear does not teach machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 3. Accordingly, the §102 rejection of claim 3 is not supported by Bussear. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 5 in view of Bussear

Claim 5 was also rejected under 35 U.S.C. §102(b) as being anticipated by Bussear. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 5, Bussear must contain all of the above claimed elements of the claim. However, Bussear does not disclose means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 5. Accordingly, the §102 rejection of claim 5 is not supported by Bussear. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 7 in view of Bussear

Claim 7 was also rejected under 35 U.S.C. §102(b) as being anticipated by Bussear. However, as described above, to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 7, Bussear must contain all of the above claimed elements of the claim. However, Bussear does not disclose machining the end of the tubular liner while the tubular liner is coupled to the wellbore casing end within the wellbore, at least in the context of claim 7. Accordingly, the §102 rejection of claim 7 is not supported by Bussear. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Rejections Under 35 U.S.C. §103Claim 2

Claim 2, which depends from claim 1, was rejected under 35 U.S.C. §103(a) as being unpatentable over Gano in view of U.S. Patent No. 6,550,539 to Maguire, et al. ("Maguire"). Applicants respectfully traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1 and, thus, its dependent claims.

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as described above, Gano fails to teach that the second tubular liner is coupled to the first tubular liner by machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing and then inserting an end of the second tubular liner into the machined end of the first tubular liner. Moreover, Maguire fails to cure the

shortcomings of Gano. That is, at least in the context of claim 1, Maguire fails to teach that the second tubular liner is coupled to the first tubular liner by machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing and then inserting an end of the second tubular liner into the machined end of the first tubular liner.

Therefore, whether taken separately or together, Gano and Maguire fail to teach or suggest the subject matter of claim 1 as a whole. Accordingly, it is impossible for the combination of Gano and Maguire to render obvious the subject matter of claim 1. Consequently, the explicit terms of §103 cannot be met by the combination of Gano and Maguire with respect to claim 1 or its dependent claims. Accordingly, Applicants respectfully request the Examiner withdraw the §103 rejection of claim 2, which depends from claim 1.

Claim 4

Claim 4, which depends from claim 3, was also rejected under 35 U.S.C. §103(a) as being unpatentable over Gano in view of Maguire. Applicants respectfully traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 3 and, thus, its dependent claims.

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, Gano fails to teach machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 3. Moreover, Maguire fails to cure the shortcomings of Gano. That is, Maguire also fails to teach machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 3.

Therefore, whether taken separately or together, Gano and Maguire fail to teach or suggest the subject matter of claim 3 as a whole. Accordingly, it is impossible for the combination of Gano and Maguire to render obvious the subject matter of claim 3. Consequently, the explicit terms of §103 cannot be met by the combination of Gano and Maguire with respect to claim 3 or its dependent claims. Accordingly, Applicants respectfully request the Examiner withdraw the §103 rejection of claim 4, which depends from claim 3.

Claim 6

Claim 6, which depends from claim 5, was also rejected under 35 U.S.C. §103(a) as being unpatentable over Gano in view of Maguire. Applicants respectfully traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 5 and, thus, its dependent claims.

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, Gano fails to teach means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 5. Moreover, Maguire fails to cure the shortcomings of Gano. That is, Maguire also fails to teach means for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing end, at least in the context of claim 5.

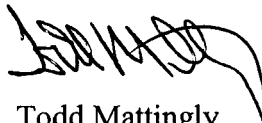
Therefore, whether taken separately or together, Gano and Maguire fail to teach or suggest the subject matter of claim 5 as a whole. Accordingly, it is impossible for the combination of Gano and Maguire to render obvious the subject matter of claim 5. Consequently, the explicit terms of §103 cannot be met by the combination of Gano and Maguire with respect to claim 5 or its dependent claims. Accordingly, Applicants respectfully request the Examiner withdraw the §103 rejection of claim 6, which depends from claim 5

Conclusion

All matters set forth in the Office Action have been addressed. Accordingly, it is believed that all claims are in condition for allowance. Favorable consideration and an early indication of allowability are respectfully requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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Dated: 10/17/06

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